

REMARKS

Introductory Comments

Reconsideration of the above-identified application in view of the above amendments and arguments set forth is respectfully requested.

Claims 62-64, 70-73, 80 and 81 are pending and under consideration. Claims 65-69, 74-79 and 82-86 are canceled in this Amendment. No new matter has been added as a result of these amendments.

Rejection of Claims 65-67, 69, 74-77, 79, 82-84 and 86

Under 35 U.S.C. § 102(e) or § 103(a)

Claims 65-67, 69, 74-77, 79, 82-84 and 86 are rejected under 35 U.S.C. § 102(e), as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cosner, U.S. Patent No. 6,353,162.

The Examiner maintains the rejection made in the previous Office Action. The Examiner states that Applicants' argument, that the claimed plants are genetically altered in a cellular level and therefore are not the same as those disclosed by Cosner, is not persuasive. The Examiner reasons that the claims encompass any New Guinea plant with a striped petal regardless of genotype.

Applicants respectfully traverse this rejection. Applicants' arguments in the previous Amendment are incorporated herein. Portions of these arguments are reiterated herein for the Examiner's convenience.

Cosner discloses the following (column 2, lines 56-60, as cited by the Examiner):

"X-rays or chemical mutagens have been typically used to induce sports off a single seedling. This process is unpredictable and has a low yield. Moreover, it is expensive, inconvenient, and inherently dangerous to use x-ray labs or chemical mutagens to induce the sports. A simpler, less expensive, safer, and more predictable process of producing asexually

reproducible sports off a single seeding would be desirable and advantageous (emphasis added)."

Applicants submit that Cosner teaches away from using mutagens, electromagnetic radiation or ion beams for modifying the claimed plants. Since the claimed plants are genetically altered in a cellular level while Cosner's plants are not, the claimed plants are not the same as those disclosed by Cosner.

Applicants will now address the Examiner's arguments.

First, as stated above, Cosner teaches away from using Applicants' claimed method as evidenced from Cosner's explicit disclosure reiterated above. Applicants respectfully submit that to modify Cosner's own teaching in order to obtain Applicants' claimed invention involves the use of hindsight and is therefore improper. The Examiner refutes this argument by stating that Cosner uses the word "typically" in the first recited sentence above. However, Applicants submit that this does not alter Cosner's explicit teaching against using X-rays or chemical mutagens to change the color or pattern of New Guinea impatiens. In the second sentence recited above, Cosner clearly states that it is expensive, inconvenient and dangerous to use these technologies. In the third sentence, Cosner states that a simpler, less expensive and safer process can be used.

Therefore, it is clearly improper to modify the Cosner reference by using Cosner's specific and explicit teaching against such modification in order to arrive at Applicants' invention.

Second, another important and explicit reason which Cosner provides for not using radiation or chemical mutagens for modifying plants is unpredictability. Cosner's first sentence above regarding using radiation or chemical mutagens pertains to plants in general and is not specific to the success in using these techniques to specific plants such as New Guinea impatiens. In fact, as evidenced from the passage above, Cosner teaches that it is due to the unpredictability nature of these processes that would lead one skilled in the art away from using them.

Finally, it is unclear as to the Examiner's rebuttal that the claims encompass any New Guinea plant with a striped petal regardless of genotype.

The claimed plants are dependent on the claimed process of radiation or chemical mutagens which genetically changes the plants on a cellular level, and therefore changes the genotype of the plants. Therefore, the claims do not encompass any New Guinea plant with a striped petal regardless of genotype. Cosner's plants are not somatically altered by the processes as claimed but are produced by phenotype selection and traditional breeding methods (column 9, lines 59-63).

However, in an effort to expedite prosecution of the instant application, Applicants have canceled claims 65-69, 74-79 and 82-86.

For all of the above reasons, Applicants respectfully request withdrawal of the rejection of claims 65-67, 69, 74-77, 79, 82-84 and 86 under 35 U.S.C. § 102(e), as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cosner, U.S. Patent No. 6,353,162.

Rejection of Claims 68, 78 and 85 Under 35 U.S.C. § 103(a)

Claims 68, 78 and 85 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Cosner, U.S. Patent No. 6,353,162 in view of Stephens *et al.*, "XII Micropropagation of *Impatiens* spp.", Biotechnology in Agriculture and Forestry, Vol. 20, 1992 (herein "Stephens").

The Examiner maintains the rejection made in the previous Office Action because according to the Examiner, Cosner is not deficient as argued by Applicants above.

Applicants respectfully traverse this rejection. Applicants' arguments made in the previous Amendment are incorporated herein. As further explained above, Cosner is clearly deficient with respect to the instant claims and Stephens does not cure the deficiencies of Cosner.

However, in an effort to expedite prosecution of the instant application, Applicants have canceled claims 65-69, 74-79 and 82-86.

Therefore, the rejection of claims 68, 78 and 85 under 35 U.S.C. § 103(a), as being unpatentable over Cosner, U.S. Patent No. 6,353,162 in view of

Stephens *et al.*, "XII Micropropagation of *Impatiens* spp.", Biotechnology in Agriculture and Forestry, Vol. 20, 1992, is now moot.

Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 62-64, 70-73 and 80-81 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Cosner, U.S. Patent No. 6,353,162 in view of Datta, "Ornamental Plants Role of Mutation", Daya Publishing House, Delhi – 110035, 1997, Broertje *et al.*, "Application of Mutation Breeding Methods in the Improvement of Vegetatively Propagated Crops", Elsevier Scientific Publishing Company, 1978 (herein "Broertje") and Sharova *et al.*, "Mutation Variability of Decorative Flowering Annual Plants", Bulletin of the Moldavian SSR Academy of Sciences, No. 3, 1973, pp. 47-53 (translated) (herein "Sharova").

The Examiner maintains the rejection made in the previous Office Action because according to the Examiner, Cosner is not deficient as argued by Applicants above.

Applicants respectfully traverse this rejection. Applicants' arguments made in the previous Amendment are incorporated herein. As further explained above, Cosner is clearly deficient with respect to the instant claims and Datta, Broertje and Sharova do not cure the deficiencies of Cosner.

Additionally, Applicants respectfully submit that the Examiner did not refute Applicants' discussion of the deficiencies of Datta, Broertje and Sharova. These deficiencies are reiterated herein for the Examiner's convenience.

Although Datta discloses using gamma rays for changing the flower color, Datta does not disclose nor suggest a method for altering the color of a New Guinea impatiens plant to have an altered or striped color as claimed. Datta discloses using gamma rays on plants other than New Guinea impatiens plants. Datta does not disclose nor suggest that its method would work on New Guinea impatiens plants and consistently produce the striped color as claimed. Applicants submit that there is no reasonable expectation of success even if one were to modify Cosner's plants with the method disclosed by Datta based on the Examiner's reasoning that Cosner is able to produce striped flowers. The striped

flowers of Cosner are produced by phenotype selection and traditional breeding methods (column 9, lines 59-63) as opposed to modifying the plants by radiation or chemical mutagens.

Broertjes discloses using chemical mutagens on plants (page 13). Although Broertjes discloses in Chapter 5 irradiation of ornamental plants, Broertjes does not disclose nor suggest a method for altering the color of a New Guinea impatiens plant to have an altered or striped color as claimed. Broertjes discloses using gamma rays on plants other than New Guinea impatiens plants. Broertjes does not disclose nor suggest that its method would work on New Guinea impatiens plants and consistently produce the striped color as claimed. Applicants submit that there is no reasonable expectation of success even if one were to modify Cosner's plants with the method disclosed by Broertjes based on the Examiner's reasoning that Cosner is able to produce striped flowers. The striped flowers of Cosner are produced by phenotype selection and traditional breeding methods (column 9, lines 59-63) as opposed to modifying the plants by radiation or chemical mutagens.

Sharova discloses mutation of flowering plants (page 1). Sharova discloses that features of the plants are changed, such as the shape (page 4), size (page 5), changing one color to another (page 4 where the color of a flower is changed from orange to yellow), producing circular spots (pages 9 and 11), and flower numbers (page 11). Sharova does not disclose or suggest a method for altering the color of a New Guinea impatiens plant to have an altered or striped color as claimed. Sharova does not disclose nor suggest that its method would work on New Guinea impatiens plants and consistently produce the striped color as claimed. Applicants submit that there is no reasonable expectation of success even if one were to modify Cosner's plants with the method disclosed by Sharova based on the Examiner's reasoning that Cosner is able to produce striped flowers. The striped flowers of Cosner are produced by phenotype selection and traditional breeding methods (column 9, lines 59-63) as opposed to modifying the plants by radiation or chemical mutagens.

For all of the above reasons, Applicants respectfully request withdrawal of the rejection of claims 62-64, 70-73 and 80-81 under 35 U.S.C. § 103(a), as being unpatentable over Cosner, U.S. Patent No. 6,353,162 in view of Datta, "Ornamental Plants Role of Mutation", Daya Publishing House, Delhi – 110035, 1997, Broertje *et al.*, "Application of Mutation Breeding Methods in the Improvement of Vegetatively Propagated Crops", Elsevier Scientific Publishing Company, 1978 and Sharova *et al.*, "Mutation Variability of Decorative Flowering Annual Plants", Bulletin of the Moldavian SSR Academy of Sciences, No. 3, 1973, pp. 47-53 (translated).

CONCLUSION


Applicants respectfully submit that the claims comply with the requirements of 35 U.S.C. Sections 102 and 103. Accordingly, a Notice of Allowance is believed in order and is respectfully requested.

Should the Examiner have any questions concerning the above, she is respectfully requested to contact the undersigned at the telephone number listed below. If the Examiner notes any further matters which the Examiner believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account no. 23-0785.

Respectfully submitted,

Scott Trees *et al.*

A handwritten signature in dark ink, appearing to read "Lisa V. Mueller", is written over a horizontal line.

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